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09/747,332	12/22/2000	Kenneth L. Davis	109869-130070	1296

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EXAMINER

PILLAI, NAMITHA

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/747,332

Applicant(s)

DAVIS, KENNETH L.

Examiner

Namitha Pillai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3, 5-13 and 15-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U. S. Patent No. 5,526,478 (Russell, Jr. et al.).

Referring to claims 1 and 11, Russell discloses a method for detecting a pointer in proximity of a geometry piece of a mechanical design having multimedia associated with the geometry piece of the mechanical design, wherein as clearly seen in Figure 4A (reference number 40) that the geometry piece associated with the multimedia belongs in a mechanical design (column 2, lines 37-39 and lines 44-45 and column 8, lines 1-15). Russell also discloses automatically generating an icon, in this case represented as the markers, with these icons or markers being associated with the geometry piece of the mechanical design for accessing the associated multimedia (column 2, lines 42-45 and reference number 42, Figure 4A). See column 8, lines 45-50.

Referring to claims 2 and 12, Russell discloses generating the icon comprising automatically generating a leader line entity from the geometry piece (reference number 42, Figure 4A).

Referring to claims 3 and 13, Russell discloses automatically generating the icon at an end of the leader line entity opposite the geometry piece, as seen by the relation of the reference numbers 41 and 42, to each other in Figure 4A.

Referring to claims 5 and 15, Russell discloses the marker including a means for linking to an application to execute the multimedia (column 8, lines 14-16).

Referring to claims 6, 16 and 22, Russell discloses determining if a request to associate multimedia with the geometry piece is received, as shown by step 154 on Figure 9, wherein this step determines if an association should be made between a multimedia file and a geometry piece (column 11, lines 28-29). Russell then goes to disclose facilitation association between the multimedia and the geometry piece upon determining the request to associate the multimedia with the geometry piece is received (column 11, lines 31-33). Russell discloses then selecting a type of multimedia to be associated with the geometry piece and wherein the markers or icons generated would then be associated or linked with the geometry piece for accessing the associated multimedia (column 11, lines 36-42).

Referring to claims 7 and 17, Russell discloses that receiving the request involves receiving a cursor selection on the geometry piece (column 11, lines 20-22).

Referring to claims 8 and 18, Russell discloses displaying a menu for selection of a type of multimedia to be associated with the geometry piece as shown by reference number 53-55 in Figure 4B, wherein the "Attach" option under each of these types would associate the media type with the selected geometry piece.

Referring to claims 9 and 19, Russell discloses that the types of multimedia comprises receiving the selection of at least one of an audio note, a textual note and an animation note, as shown by reference number 53-55 in Figure 4B and the "Label 1" shown in Figure 5.

Referring to claims 10 and 20, Russell discloses the leader line entity, represented as reference number 41 of Figure 4A, being input by the user (column 11, lines 19-22).

Referring to claim 21, Russell discloses a method for detecting a pointer in proximity of a geometry piece of a mechanical design having multimedia associated with the geometry piece of the mechanical design wherein as clearly seen in Figure 4A (reference number 40) that the geometry piece associated with the multimedia belongs in a mechanical design (column 2, lines 37-39 and lines 44-45 and column 8, lines 1-15). Russell also discloses automatically generating an icon, in this case represented as the markers, with these icons or markers being associated with the geometry piece of the mechanical design for accessing the associated multimedia (column 2, lines 42-45 and reference number 42, Figure 4A). Russell discloses processor coupled to the machine accessible medium to execute the instructions for carrying out the invention, as disclosed (column 4, lines 25-29). See column 8, lines 45-50.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell.

Referring to claims 4 and 14, Russell does not disclose that the icon would be generated based on the type of multimedia associated with the geometry piece. Russell does disclose that the shapes of these markers or icons could take any form. It would have been obvious for one skilled in the art, at the time of the invention to generate icons corresponding to the type of multimedia associated with the geometry piece. Russell clearly discloses that the shapes that the icons are represented by can take any form, hence suggesting a shape that is more indicative of

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the type of media being represented. It would also be more convenient and cause less confusion for the users to determine the type of media that is associated with the geometry by merely looking at the marker or icon at the end of the line. This way the user without accessing the file can determine the type of media being represented, thereby providing motivation for such an icon representation to be used. One skilled in the art would have been motivated at the time of the invention to generate icons corresponding to the type of multimedia associated with the geometry piece.

#### ***Response to Claim Changes***

3. The Examiner acknowledges Applicant's amendments to claims 1, 11 and 21 to better specify the present invention. However, all claims are still rejected under 35 U. S. C. 102 and 103 as being previously disclosed in prior art.

#### ***Response to Arguments***

4. Applicant's arguments filed 10/20/03 have been fully considered but they are not persuasive.

With respect to Applicant's arguments that Russell does not state the annotation of multimedia element to a mechanical design. Russell may refer to the mechanical design of Figures 4 as a 3-D model as a general description, but as seen in the Figures 4, the model is a mechanical design format as seen in CAD programs, wherein the 3-D model is a mechanical model that is being manipulated by the user to be designed in a specific format.

With respect to Applicant's arguments that Russell does not teach allowing a finer grain of granularity for annotating a mechanical design. The mechanical design aspect is clearly seen in both Figure 1 of the Applicant's invention and Figures 4 of Russell both showing a

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mechanical design, wherein the granularity of one may be more finer than that of Russell. But this is based on the choices of the user of the component chosen within the mechanical design, wherein if a user chooses a finer geometric element within the mechanical design, the annotation would be allowable even with such a smaller more specific element, since all geometric components can be annotated in Russell's invention. Furthermore, allowing a finer grain of granularity for annotating a mechanical design does not seem to be addressed in Applicant's claims, thereby clearly showing that the claimed invention is disclosed in Russell.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington D.C. 20231. If applicant desires to fax a response, central FAX number (703) 872-9306 may be used. NOTE: A Request for Continuation (Rule 60 or 62) cannot be faxed. Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final

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responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

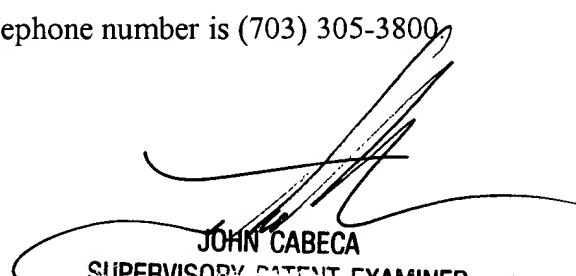
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namitha Pillai whose telephone number is (703) 305-7691. The examiner can normally be reached on 8:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Namitha Pillai  
Assistant Examiner  
Art Unit 2173  
January 6, 2004



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